



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 5

SANFORD ASTOR
SUITE 200
10507 WEST PICO BLVD.
LOS ANGELES, CA 90064

COPY MAILED

MAY 13 2002

OFFICE OF PETITIONS

In re Application of
William Moulton, Steven Wolff,
Rod Schumacher, Andrew Bryant,
Marcy Hamilton, Strath Hamilton,
and Dana Taschner
Application No. 10/027,191
Filed: December 20, 2001
Attorney Docket No. 50770
Title: FILM LANGUAGE

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition, as refiled March 27, 2002 (original filed December 20, 2001), under 37 CFR 1.47(a). This petition was recently forwarded to the Office of Petitions for consideration.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on December 20, 2001, with a declaration executed by joint inventors William Moulton, Steven Wolff, Rod Schumacher, Marcy Hamilton, Strath Hamilton and Dana Taschner; an added page to the declaration signed by inventor Marcy Hamilton on behalf of non-signing inventor Andrew Bryant; and the instant petition under §1.47(a) (and petition fee). Rule 47 applicants assert that status under §1.47(a) is proper because inventor Bryant refuses to execute the declaration. In support thereof, applicant submits a statement of facts of joint inventor Marcy Hamilton stating that non-signed inventor Bryant "was faxed the Specification and the Declaration to sign and I called him on the phone and spoke to him and he refused to sign the declaration. I spoke to him on the phone on December 14, 2001, and he refused to sign the Declaration unless he received certain sums of money."

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirements (1) and (2).

As to requirement (1), rule 47 applicant has not submitted adequate proof of refusal. The statement of facts submitted only shows that the inventor was presented with the specification and the declaration. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. See MPEP 409.03(d). Evidence making clear that a copy of all of the application papers were sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney is required. Documentary evidence supporting co-inventor Hamilton's statement, such as copies of cover letters transmitting the application papers and certified mail return receipts, should be made part of the record.

If prior to the oral refusal on December 14, 2001 inventor Bryant was not presented with all of the application papers, then rule 47 applicants must now present those papers. In such case, an additional showing of direct refusal or refusal by conduct must also be shown.

As to requirement (2), the added page to the combined Declaration and Power of Attorney is not acceptable. Rule 47 applicants, thereby, indicate that only one of the available joint inventors is signing on behalf of the non-signing inventor. This is not acceptable. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

On renewed petition, applicant must correct the following deficiencies:

1. Provide adequate proof of presentation of all of the application papers to inventor Bryant and if presentation is after December 14, 2001, of his subsequent refusal, consistent with the guidance set forth in MPEP 409.03(d)¹;
2. Supply an oath or declaration properly executed by all available joint inventors on behalf of themselves and on behalf of non-signing inventor Bryant (Rule 47 applicants are reminded that an oath or declaration with non-initialized/non-dated changes is unacceptable).

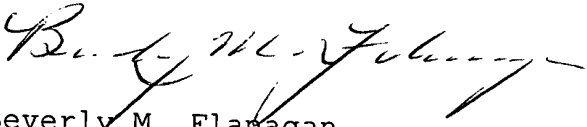
Further correspondence with respect to this matter should be addressed as follows:

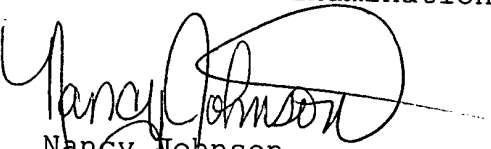
By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions
ATTN: NANCY JOHNSON

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza Four, Suite 3C23
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy


Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ 8th ed. (Rev. Aug 1, 2001).